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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/704,507	11/07/2003	Mark Dennis Norton	1578.623	4072
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DOCKET CLERK Kelly-Krause PO BOX 12608 DALLAS, TX 75225			EXAMINER CASCA, FRED A	
			ART UNIT 2617	PAPER NUMBER
			NOTIFICATION DATE 09/16/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/704,507

**Applicant(s)**

NORTON ET AL.

**Examiner**

FRED A. CASCA

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to applicant's amendment filed on June 09, 2008. Claims 1-3, 5-14 and 16 are still pending in the present application. **This Action is made FINAL.**

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP TR 25.878 v5.1.0 (hereinafter 3GPP2002-06).

3GPP2002-06 discloses a method of processing a message received at a user equipment (UE), the UE configured for use in a UMTS, Universal Mobile Telecommunications system, communications system (page 7, par. 6.2.1), wherein the message includes a Ciphering Mode Info information element the message and is one of a plurality of message types comprising a Radio Bearer Setup message, a Radio Bearer Reconfiguration message, a Radio Bearer Release message, a Transport Channel Reconfiguration message, a Physical Channel Reconfiguration message, a Cell Update Confirm message, a URA, UTRAN Registration Area, Update Confirm message and a UTRAN, Universal Terrestrial Radio Access Network, Mobility Information message (page 16, par. 7.3.1, lines 5-9), the method comprising:

determining whether a Ciphering Activation Time for DPCH, Dedicated Physical Channel, information element that identifies a ciphering activation time is present in the message when radio bearers exist using radio link control (RLC) transparent mode (TM) (page 18 lines 37-39 and page 19, lines 1-13); and in the event that the Ciphering Activation Time for DPCH information element is not present (page 18 lines 37-39 and page 19, lines 1-13).

3GPP2002-06 does not specifically disclose returning a message indicating the absence of the information element.

However, 3GPP2002-06 discloses if the received reconfiguration message did not contain the IE "Ciphering activation time for DPCH" in IE "Ciphering mode info" ... include the IE "COUNT-C" activation time (page 19, lines 1-15).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the above 3GPP2002-06 disclosure in the format claimed for the purpose of providing an efficient communication system.

Referring to claim 2, 3GPP2002-06 discloses the method according to claim 1.

The 3GPP2002-06 does not specifically disclose wherein the step of returning a message indicating the absence of the Ciphering Activation Time for DPCH information element comprises returning a message including the value INVALID\_CONFIGURATION.

However, 3GPP2002-06 discloses many available options when the received reconfiguration message did not contain the IE "Ciphering activation time for DPCH" in IE "Ciphering mode info" (page 19, lines 1-16).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention to modify the disclosures of 3GPP2002-06 for the purpose of providing an efficient communication system.

Claim 3 is rejected for the same reasons as that of rejection of claim 2.

Claim 5 is rejected for the same reasons as that of rejection of claim 1.

Claim 6 is rejected for the same reasons as that of rejection of claim 2.

Claim 7 is rejected for the same reasons as that of rejection of claim 3.

Claim 8 is rejected for the same reasons as that of rejection of claim 2.

Referring to claim 9, 3GPP2002-06 discloses a method according to claim 5.

3GPP2002-06 does not specifically disclose wherein the step of selecting an activation time comprises selecting an activation time at the UE independently of the UTRAN and sending a response message including the selected activation time to the UTRAN.

However, 3GPP2002-06 discloses many available options when the received reconfiguration message did not contain the IE "Ciphering activation time for DPCH" in IE "Ciphering mode info" (page 19, lines 1-16), and further discloses setting the variable INVALID\_CONFIGURATION (Page 20, lines 1-6).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention to modify the disclosures of 3GPP2002-06 for the purpose of providing an efficient communication system.

Claim 10 is rejected for the same reasons as that of rejection of claim 2.

Claim 11 is rejected for the same reasons as that of rejection of claim 3.

Claims 12-13 are rejected for the same reasons as that of rejection of claims 8-9.

Claim 14 is rejected for the same reasons as that of rejection of claim 1.

Claim 16 is rejected for the same reasons as that of rejection of claim 5.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-3, 5-14 and 16 have been considered but are not persuasive.

In response to applicant's arguments that it would not be obvious to modify the 3GPP disclosure in the claimed format, the examiner respectfully disagrees.

Page 19 of the 3GPP reference, lines 5-6 and 13, explicitly recites the following:

if the received reconfiguration message did not contain the IE "Ciphering activation time for DPCH" in IE "Ciphering mode info," include the IE "COUNT-C activation time" and specify a CFN value for this EI.

The above recitation means that when the "Ciphering activation time information element" is not present in the message, include the IE "COUNT-C activation time" in a message and specify a CFN value for this EI.

In other words, both the inclusion of "COUNT-C activation time" and "specifying a CFN value for this EI," can be presented in the form of a message that is returned in response to

determining that the “CIPHERING activation time” is missing. Further, the 3GPP clearly shows determining whether the “CIPHERING activation time information message” is present. In response to determining the “CIPHERING activation time information message” being missing the actions of including the IE “COUNT-C activation” and “specifying a CFN value” takes place. Thus, a person of ordinary skill in the art, in view of KSR, would understand that inclusion of “COUNT-C” and the specifying of a CFN value must indicate the absence of the “CIPHERING activation time” because they are performed when the “CIPHERING activation time” is missing. Thus, the inclusion of “COUNT-C activation time” and “specifying a CFN value serves as message indicating the absence of the “CIPHERING activation time.”

In response to applicant's argument that there is no suggestion in 3GPP of returning a message indicating the absence of the ciphering activation time for DPCH information element, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner respectfully disagrees with the applicant because it is clear from the 3GPP (page 19, lines 4-6 and 13) that the 3GPP reference determines whether the “CIPHERING activation time” is present in the message or not. A person of ordinary skill in the art would understand that the determining would affect the messaging procedure. Thus, it would be obvious to determine the presence of “CIPHERING activation time” and then reveal the result of

determining so that proper procedure (e.g., non-ciphering mode) are followed when the "Ciphering activation time" is not present. Further, since the communication mode will be dependent on the presence of the "Ciphering activation time," thus, it would be increase efficiency of the communication system to have knowledge whether the "Ciphering activation time" is present. Thus, the motivation would be providing an efficient communication system.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper, can be reached at (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished



applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred A. Casca/

Examiner, Art Unit 2617

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617